

REMARKS

In the Office Action, claims 1-40 and 44-60 were rejected. More specifically,

- Claims 1, 3-6, 11-14, 17-18 and 21-24 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent 5,578,808 (Taylor) in view of U.S. Patent 5,541,985 (Ishii);
- Claim 2 was rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,659,345 (Sukeda);
- Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 5,892,824 (Beatson);
- Claims 9-10 and 25 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,257,486 (Teicher);
- Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,776,332 (Allen);
- Claims 19 and 20 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,411,822 (Kraft);
- Claims 26, 28-31 and 36-40 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii;
- Claim 27 was rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Sukeda;
- Claims 32 and 33 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Beatson;
- Claims 34 and 35 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Teicher;
- Claims 44, 46-49, 52-53 and 55-58 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii;
- Claims 45 and 54 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Sukeda; and
- Claims 50-51 and 59-60 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Beatson.

By this Amendment, claims 1, 17, 26, 40, 44 and 52 have been amended and claims 2, 27, 45 and 54 have been canceled. Claims 1, 26, 44 and 52 have been amended to include the limitations of old claims 2, 27, 45 and 54, respectively. Claims 17 and 40 have been amended to correct minor typographical errors. Therefore, upon entry of this Response, claims 1, 3-26, 28-40, 44, 46-53 and 55-60 are pending. For the reasons set forth hereinbelow, Applicants respectfully request that the rejections associated with the pending claims be withdrawn.

Claims 1 and 3-25

Applicants have herein amended independent claim 1 to include the limitations of canceled claim 2.

First, Applicants submit that claim 1 is nonobvious over Taylor in view of Ishii (and in further view of Sukeda) because the cited references, either alone or in combination, fail to teach or suggest each and every limitation of claim 1. *See* MPEP §2143 (stating that one of the elements of a *prima facie* case of obviousness under §103(a) is that the prior art references must teach or suggest all the claim limitations). More particularly, Applicants submit that the combination of Taylor, Ishii and Sukeda fail to teach or suggest, among other things, “enabling the selected data transfer application for use by the user when the user satisfies an authentication mechanism that is **independent** of the selected data transfer application” as recited in claim 1.

Applicants submit that the authorization process taught by Taylor requires the submission of a first authorization code to enable access to the applications on the card (*See* Taylor, Figure 5, steps 144 and 146) and the submission of a second authorization code when an application is selected (*See* Taylor, Figure 7, steps 196 and 198). Thus, Applicants submit that the authorization process taught by Taylor is **dependent** upon – **not independent of** – the selected data transfer application as recited in claim 1.

Applicants also submit that Ishii fails to remedy the defects of Taylor with respect to claim 1. Applicants agree with the Examiner’s determination that the combination of Taylor and Ishii fails to teach or suggest, among other things, “enabling a selected data transfer application for use by the user when the user satisfies an authentication mechanism that is **independent** of the selected data transfer application” as recited in claim 1.

Applicants further submit that Sukeda fails to teach or suggest “enabling a selected data transfer application for use by the user when the user satisfies an authentication mechanism that

is **independent** of the selected data transfer application” as recited in claim 1. Sukeda is cited as teaching a smart card (110) comprising a processor for rights to play (213) for authenticating the right of play (222 and 222’) for executing application or module independently. However, Applicants submit that the authentication mechanism taught by Sukeda is performed on a game by game basis. Thus, Applicants submit that the authorization process taught by Sukeda is **dependent** upon – **not independent of** – the selected data transfer application as recited in claim 1.

Therefore, for the reasons set forth hereinabove, Applicants submit that claim 1 is nonobvious over the combination of Taylor, Ishii and Sukeda because the cited references, either alone or in combination, fail to teach or suggest each and every limitation of claim 1. *See* MPEP §2143 *id.* Applicants further submit that claims 3-25, which depend from claim 1, are also nonobvious over the cited references. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under §103(a), then any claim depending therefrom is nonobvious).

Second, Applicants submit that claim 1 is nonobvious over Taylor in view of Ishii (and in further view of Sukeda) because the cited references fail to provide the suggestion or motivation to modify Taylor to realize the invention recited in claim 1. *See* MPEP §2143 (stating that one of the elements of a prima facie case of obviousness under §103(a) is that there must be some suggestion or motivation to modify the reference or to combine reference teachings).

The Examiner has determined that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sukeda to the teachings of the combination of Taylor and Ishii. Applicants respectfully disagree with this determination and note that there is no suggestion or motivation to make the proposed modification if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. *See* MPEP § 2143.01.

Applicants submit that modifying the combination of the multi-application data card of Taylor and the cellular phone of Ishii with the gaming application of Sukeda would render the cellular phone unsatisfactory for its intended purpose. Ishii checks whether the inserted IC card is a credit card or a prepaid card. *See* Ishii, col. 6, ll. 3-8. If the data on the IC card is abnormal, an message stating such abnormality is indicated. *See id.*, col. 4, ll. 24-27. In other words, if the IC card inserted into the cellular phone of Ishii is not one of a credit card or a prepaid card, an

abnormal operation is indicated. Sukeda does not teach a credit card or a prepaid card, but a data card for playing gaming applications. As such, the combination of Taylor, Ishii and Sukeda would result in an inoperative system. Therefore, Applicants submit that claim 1 is nonobvious over the cited references, and further submit that claims 3-25, which depend from claim 1, are also nonobvious over the cited references. See MPEP §2143.03.

Accordingly, for the reasons set forth hereinabove, Applicants request that the §103(a) rejections associated with claims 1 and 3-25 be withdrawn.

Claims 26 and 28-40

Applicants have herein amended independent claim 26 to include the limitations of canceled claim 27. Therefore, claim 26 has been amended in a manner similar to that of claim 1.

Accordingly, for reasons similar to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 26 and 28-40 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 26 and 28-40 be withdrawn.

Claims 44 and 46-51

Applicants have herein amended independent claim 44 to include the limitations of canceled claim 45. Therefore, claim 44 has been amended in a manner similar to that of claim 1.

Accordingly, for reasons similar to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 44 and 46-51 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 44 and 46-51 be withdrawn.

Claims 52-53 and 55-60

Applicants have herein amended independent claim 52 to include the limitations of canceled claim 54. Therefore, claim 52 has been amended in a manner analogous to that of claim 1.

Accordingly, for reasons analogous to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 52, 53 and 55-60 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 52, 53 and 55-60 be withdrawn.

CONCLUSION

Applicant respectfully requests a Notice of Allowance for the pending claims in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

In the event that an additional fee is required for this response, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0436.

Respectfully submitted,
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